

## SECTION II—REMARKS

Applicants thank the Examiner for a thorough review, and respectfully request reconsideration of the above referenced patent application for the following reasons:

### **Claims 1-10, 17-30 and 33-35 rejected under 35 U.S.C. § 103(a)**

The Office Action rejected claims 1-10, 17-30 and 33-35 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0205104 to Harvey, et al. (“Harvey”) in view of “Understanding Web Services: *XML, WSDL, SOAP and UDDI*,” by Eric Newcomer (“Newcomer”). Applicants respectfully disagree. In particular, independent claim 1, as amended herein, recites in pertinent part:

... **generating multiple views of the Web service implementation** based on the Web service definitions, wherein each of the multiple views is publishable as a separate Web service  
... .

The Office Action concedes that Harvey fails to disclose “**multiple views**” as Applicants recite in claim 1. Refer to the Office Action at page 3, paragraph 5. However, the Office Action states that Figure 5-2 of Newcomer, at page 162, depicts “a UDDI server [that] is capable of ... **allowing for multiple different implementations** of a service.” However, Newcomer does not expressly disclose “**multiple different implementations** of a service.” The Office Action does not rely on any express language of Newcomer or highlight any specific passage, but merely cites to Figure 5-2 and a portion of Newcomer’s description of Figure 5-2. Newcomer limits the description of Figure 5-2 to generally describing a “containment hierarchy” having various “elements,” “fields,” and “key references” used to form “[r]elationships among data structures.”

Newcomer is silent with respect to “**generating multiple views of the Web service implementation**,” as Applicants recite in amended claim 1.

A rejection of “obviousness” is proper when, “though the invention is not identically **disclosed or described as set forth in section 102** ... the differences ... would have been obvious ... .” U.S.C. 35 § 103(a). A rejection under 35 U.S.C. § 102 is appropriate “only if each and every element as set forth in the claim is found, **either expressly or inherently described** ... .” See M.P.E.P. § 2131.

Because Newcomer does not “**expressly**” describe “generating multiple views of the Web service implementation,” as claimed by Applicants, the Office Action apparently relies on a theory of **inherency** to anticipate this limitation of claim 1. The M.P.E.P. states that “**inherent disclosures** of a prior art reference **may be relied upon** in the rejection of claims under 35 U.S.C. 102 or 103.” See M.P.E.P. § 2112. However, the M.P.E.P. further states:

In relying upon the **theory of inherency**, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily flows from the teachings of the applied prior art**. [Refer to M.P.E.P. § 2112(IV), quoting *Ex parte Levy*.]

Applicants respectfully submit that the Office Action fails to provide the requisite “technical reasoning” showing that the allegedly inherent characteristic, “generating multiple views of the Web service implementation” as claimed by Applicants, “**necessarily flows**” from Newcomer as applied to Harvey. The Office Action does state that Newcomer discloses, “[a] business entity can have multiple ‘tModels’ for the same ‘businessService’ being offered, **thereby offering many different implementations of the same service**,” however, this conclusion is insufficient to support a proper finding of inherency for a limitation that is not

expressly disclosed in the prior art. “The fact that a certain result or characteristic **may occur or be present** in the prior art is **not sufficient** to establish the inherency.” See M.P.E.P. § 2112(IV).

Because the combination of Harvey and Newcomer, whether considered alone or in combination, fail to disclose each and every limitation in as complete detail as Applicants recite in independent claim 1, Applicants respectfully submit that claim 1 is patentable over the references and in condition for allowance. Independent claims 17, 28, and 33 recite similar limitations. Dependent claims 2-10, 18-27, 29-30 and 34-35 directly or indirectly incorporate all the limitations of the independent base claims upon which they depend, and thus, for at least the reasons stated above, are patentable over the references and in condition for allowance.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection to claims 1-10, 17-30 and 33-35.

**Claims 11-16, 31-32, and 36-37 rejected under 35 U.S.C. § 103(a)**

The Office Action rejected claims 11-16, 31-32, and 36-37 under 35 U.S.C. § 103(a) as being unpatentable over Harvey in view of Newcomer, and further in view of “BEA WebLogic Server 6.1” (“BEA”).

Dependent claims 11-16, 31-32, and 36-37 each directly or indirectly incorporate all the limitations of the independent base claims upon which they depend. Newcomer and BEA, whether considered alone or in any combination, fail to cure the deficiencies of Harvey as discussed above with reference to the rejection of independent claim 1 under 35 U.S.C. § 103(a), as each fails to disclose, “generating multiple views of the Web service implementation,” as Applicants recite in amended independent claim 1. Therefore, for at least the reasons stated

above in reference to independent claim 1, Applicants respectfully submit that dependent claims 11-16, 31-32, and 36-37 are patentable over the references and are in condition for allowance.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection to claims 11-16, 31-32, and 36-37.

## CONCLUSION

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked subject matter in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such subject matter may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (503) 439-8778.

### **Charge Deposit Account**

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

/Gregory D. Caldwell/  
Gregory D. Caldwell  
Registration No. 39,926  
Attorney for Applicants

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Blakely, Sokoloff, Taylor & Zafman LLP  
1279 Oakmead Parkway  
Sunnyvale, CA 94085-4040  
Telephone: (503) 439-8778  
Facsimile: (503) 439-6073